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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,624	03/23/2001	Walter Canis	END9-2000-0145US1	7110
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HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FL ALBANY, NY 12207			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/816,624	<b>Applicant(s)</b> CANIS ET AL.	
	<b>Examiner</b> George C. Neurauter, Jr.	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

Claims 1-28 are currently presented and have been examined.

***Response to Arguments***

Applicant's arguments filed 14 November 2005 have been fully considered but they are not persuasive.

The Applicant continues to argue that Pulsipher does not teach the collection of device identification and detail information from each device and wherein the information is collected at predetermined times. The Examiner maintains the views previously presented.

The Applicant also argues that there is no suggestion or motivation to combine Pulsipher in view of Steele. The Examiner previously provided such motivation in the previous rejection. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Also, both references are directed to collecting device information and detail information about devices on a network.

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It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose, the idea of combining them flows logically from their having been individually taught in the prior art. See MPEP 2144.06 and *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-28 recite "device characteristic information" and "software information". However, these limitations was not

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described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

If the Applicant traverses this rejection, the Applicant must specifically point out the written description of these limitations within the specification in order to overcome this rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-7, 10-13, 15-19, 22-25, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5 948 055 to Pulsipher et al.

Regarding claim 1, Pulsipher discloses a system for mapping a network, comprising:

a collection system for collecting device identification and detail information ("topology data") from devices on the network by communicating with each device to retrieve the device

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identification and detail information, wherein the detail information includes device characteristic information and software information; (column 7, lines 41-57)

a timer system for collecting the device identification and detail information at predetermined scheduled times; (column 3, lines 36-39; column 7, lines 41-57, specifically lines 44-49)

an analysis system for analyzing the collected device identification and detail information (column 8, lines 7-24)

a report system for generating a mapping report based on the analyzed device identification and detail information. (column 8, lines 38-49)

Regarding claim 2, Pulsipher discloses the system of claim 1, wherein the collection system comprises at least one collection tool for collecting the device identification and detail information. (column 7, lines 41-57, specifically "network monitor")

Regarding claim 3, Pulsipher discloses the system of claim 2, wherein the analysis system comprises rules for resolving any conflicts between device identification and detail information collected by at least one collection tool. (column 11, lines 8-19)

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Regarding claim 6, Pulsipher discloses the system of claim 1, further comprising a permission system for gaining user access to the network. (column 6, lines 11-35 and 62-64)

Regarding claim 10, Pulsipher discloses the system of claim 9, wherein the report system outputs the generated report. (column 8, lines 38-49 and 52-54, specifically lines 41-49 and 52-54)

Regarding claim 12, Pulsipher discloses a method for mapping a network, comprising the steps of:

installing collection tools on a collection apparatus;  
(column 6, lines 52-59)

communicating the collection apparatus with the network;  
(column 6, lines 26-28 and 36-45)

operating the collection tools to collect device identification and detail information from devices on the network; (column 7, lines 41-57)

analyzing the device identification and detail information;  
(column 8, lines 7-24) and

reporting the analyzed device identification and detail information. (column 8, lines 38-49)

Regarding claim 13, Pulsipher discloses the method of claim 12, wherein the collection apparatus comprises at least one processor. (column 6, lines 19-20)

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Claim 7 is rejected since claim 7 recites a system that contains substantially the same limitations as recited in claims 1-3 in combination.

Claim 11 is rejected since this claim recites a system that contains substantially the same limitations as recited in claim 6.

Claim 15 is rejected since this claim recites a method that contains substantially the same limitations as recited in claim 3.

Claims 17-19 and 22 are rejected since these claims recite a program product that contains substantially the same limitations as recited in claims 1-3 and 6 respectively.

Claims 23-25 and 28 are rejected since these claims recite a computer system that contains substantially the same limitations as recited in claims 1-3 and 6 respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.



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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-5, 8-9, 14, 20-21, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulsipher et al in view of US Patent 6 282 175 to Steele et al.

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Regarding claim 4, Pulsipher discloses the system of claim 1 wherein the device identification and detail information includes device identity, device addresses, device characteristics, software installed on the devices, and software characteristics of the devices on the network. (column 7, line 65-column 8, line 6)

Pulsipher does not disclose wherein the device identification and detail information includes operating system software installed on the devices, however, Pulsipher does disclose wherein the device may be a computer (column 7, line 67-column 8, line 2, specifically column 8, line 1).

Steele discloses wherein device identification and detail information includes operating system software installed on the devices (column 2, lines 32-40)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Steele discloses that collecting information concerning the operating system allows identification of what has changed in the configuration of a computer which aids in troubleshooting and management of a computer system network (column 2, lines 1-4). In view of these specific advantages and that the references are directed to collecting device identification and detail information about

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devices on a network, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claims 8, 14, 20, and 26 are also rejected since these claims recite a system, method, program product, and computer system that contain substantially the same limitations as recited in claim 4.

Regarding claim 5, Pulsipher discloses the system of claim 4 wherein the generated mapping report includes the device identities, device types, the device addresses, the device characteristics, the software installed on the devices, and the software characteristics. (column 7, line 65-column 8, line 6; column 8, lines 38-49, specifically "topology data")

Pulsipher does not disclose wherein the generated mapping report includes operating system software installed on the devices, however, Pulsipher does disclose wherein the device may be a computer (column 7, line 67-column 8, line 2, specifically column 8, line 1).

Steele discloses wherein a generated mapping report includes operating system software installed on the devices (column 2, lines 13-15 and 32-40)

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Claim 5 is rejected since the motivations regarding the obviousness of claim 4 also apply to claim 5.

Claims 9, 21, and 27 are also rejected since these claims recite a system, method, program product, and computer system that contain substantially the same limitations as recited in claim 5.

**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C.

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Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

  
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